

## **REMARKS**

Claims 1 to 30 are pending in this application and are newly rejected. All previous rejections have been withdrawn. Applicant is herein amending claims 1, 8, 12-14, and 16-30. Applicant requests entry of the amendment and reconsideration of the rejections in light of the amendments and following remarks.

### **Claim Amendments**

Applicant is herein amending claims 1, 18 to 20, 22 to 24, and 27 to provide proper antecedent basis for the terms used in the claims. Applicant is amending claim 26 to add a missing period at the end of the claim. No new matter is added by the claim amendments.

Applicant is herein amending device claims 1, 8, 12, 17, 24, 29, and 30 to further specify how the sensed light energy is controlled. Applicant is herein amending method claims 18 and 28 to further specify the control of the sensed light energy. No new matter is added by the claim amendments.

### **Rejection under 35 U.S.C. § 112, second paragraph**

Claims 1, 18 to 20, 22 to 24, 27, and 30 are rejected under 35 U.S.C. § 112, second paragraph as lacking proper antecedent basis with respect to the terms “said electronic image capture system,” “said exposure system,” and/or “said flash unit.” Applicant is herein amending claims 1, 18-20, 22-24, 27, and 30 to provide proper antecedent basis for the terms used in the claims, thereby rendering the rejection of these claims moot. Therefore, applicant requests withdrawal of the rejection of claims 1, 18-20, 22-24, 27, and 30 under 35 U.S.C. § 112.

**Rejections under 35 U.S.C. § 103(a)**

***Claims 1 to 3 and 7 to 30***

Claims 1-3 and 7-30 are rejected over US-A-5,049,911 (“Shimizu patent”) in view of US-A-4,395,102 (“Pizzuti patent”). Applicant traverses the rejection because a skilled artisan would not have combined the teachings of the Shimizu patent and the Pizzuti patent and, even if the two patents were combined, they would not teach the claimed techniques, as set forth in claims 1-3 and 7-30, as a whole.

To establish a proper *prima facie* rejection, the following elements must be shown:

- (1) the reference(s) is (are) available as prior art against the claimed invention;
- (2) the motivation (explicit or implicit) provided by the reference(s), common sense, or common knowledge that would have rendered the claimed invention obvious to one of ordinary skill in the art at the time of the invention;
- (3) a reasonable expectation of success;
- (4) the basis for concluding that the claimed invention would have been obvious to do; and
- (5) the reference(s) teach(es) the claimed invention as a whole.

*KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007).

Applicant submits that all of the above elements have not been established. Hence, a *prima facie* obviousness rejection is improper, as explained below.

Shimizu does not disclose an exposure control system adapted to control the scanning aperture shutter and a flash unit in response to sensed light energy at the photocell to control a ***variable amount of fill flash energy*** received by the electronic image capture device. The Office acknowledges this deficiency with respect to Shimizu patent on page 3 of the latest Office Action and turns to the Pizzuti patent to remedy the deficiency. The Pizzuti patent is directed to bellows for a film-based folding camera.

Applicant submits that a skilled artisan would not have looked to the Pizzuti patent, which discloses bellows for a film-based folding camera, to remedy the deficiency in the Shimizu patent, which discloses a still video camera, because electronic image devices, such as electronic cameras. As described in applicant's disclosure, electronic imaging devices capture images differently from film-based cameras. Specification, para. [0002]. In electronic cameras, the light sensed at each pixel is integrated over a period of time. *Id.* The problems encountered in pixel integration include controlling the amount of time each pixel is integrated, controlling fill flash where objects in the scene are located at various distances from the camera, and balancing illumination of between natural and artificial light sources in the pixel integration. Paras. [0002] and [0003]. Applicants respectfully submit that a skilled artisan attempting to solve issues dealing with pixel integration of digital cameras would not turn to film-based camera because film-based cameras do not perform pixel integration.

Furthermore, the combination of references does not achieve the applicants' claimed devices and methods, as set forth in claims 1-3 and 7-30. Applicant submits that the Shimizu patent does not disclose a scanning aperture shutter, as required in claim 1. In particular, the scanning aperture shutter of the electronic camera of claim 1 is not only able to control light energy received by the electronic image capture device from said image scene, but also to control the light energy received and sensed by the photocell from the image scene. In this manner, the light energy sensed by photocell according to claim 1 is analogous to the light energy received by the image capture device. Applicants further submit that the cited portions of the Pizzuti patent fail to overcome the deficiency of the Shimizu patent, and the Pizzuti patent is not cited for that purpose.

Since a skilled artisan would not combine the Shimizu patent with the Pizzuti patent and, even if one were to combine them, one would not achieve applicant's claimed techniques, as set forth in claims 1-3 and 7-30. Accordingly, applicant requests withdrawal of the obviousness rejection of these claims.

***Claims 4 and 5***

Claims 4 and 5 are rejected over the Shimizu patent in view of the Pizzuti patent in further review of US-A-4,941,011 (“Farrington patent”). Claims 4 and 5 depend from claim 1 directly or indirectly. The Farrington patent does not remedy the deficiencies in the Shimizu patent and the Pizzuti patent. Accordingly, applicant submit that claims 4 and 5 are not obvious and request withdrawal of the rejection.

***Claim 6***

Claim 6 is rejected over the Shimizu patent in view of the Pizzuti patent in further review of US-A-5,943,515 (“Omura patent”). Claim 6 depends directly from claim 1. The Omura patent does not remedy the deficiencies in the Shimizu patent and the Pizzuti patent. Accordingly, applicant submit that claim 6 is not obvious and request withdrawal of the rejection.

In view of the foregoing arguments, applicant submits that the Office has failed to establish a proper *prima facie* obviousness rejection and, therefore, requests the Office to withdraw the rejections of claims 1 to 30 under 35 U.S.C. § 103(a).

**Conclusions**

Applicants request:

- (1) entry of the amendments to the specification and claims;
- (2) reconsideration and withdrawal of the rejections of the claims 1 to 30; and
- (3) allowance of claims 1 to 30.

If the Examiner is of a contrary view, the Examiner is requested to contact the undersigned attorney at (206) 332-1102.

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